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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,878	01/23/2002	Macino Giuseppe	6360	5622

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EXAMINER

QIAN, CELINE X

ART UNIT

PAPER NUMBER

1636

DATE MAILED: 02/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/913,878

Applicant(s)

GIUSEPPE ET AL.

Examiner

Celine X Qian

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-23 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claims 1-23 are pending in the application.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-11 and 14, drawn to a nucleotide sequence encoding for a protein having a silencing activity and in comprising a RNA-dependent domain, wherein the domain is homologous to a portion of SEQ ID NO:1

Group II, claim(s) 12, drawn to plants or plant organ transformed with a vector comprising a nucleotide sequence encoding for a protein having a silencing activity and in comprising a RNA-dependent domain, wherein the domain is homologous to a portion of SEQ ID NO:1.

Group III, claim 13, drawn to a plant mutated at the nucleic acid sequence encoding for a protein having a silencing activity and in comprising a RNA-dependent domain, wherein the domain is homologous to a portion of SEQ ID NO:1, wherein the silencing activity is reduced or inhibited.

Group IV, claim 15, drawn to a fungus mutated at the nucleic acid sequence encoding for a protein having a silencing activity and in comprising a RNA-dependent domain, wherein the domain is homologous to a portion of SEQ ID NO:1, wherein the silencing activity is reduced or inhibited.

Group V, claim 16, drawn to a non-human animal transformed with the vector comprising a nucleotide sequence encoding for a protein having a silencing activity and in comprising a RNA-dependent domain, wherein the domain is homologous to a portion of SEQ ID NO:1.

Group VI, claim 17, drawn to a non-human animal mutated at the nucleic acid sequence encoding for a protein having a silencing activity and in comprising a RNA-dependent domain, wherein the domain is homologous to a portion of SEQ ID NO:1, wherein the silencing activity is reduced or inhibited.

Group VII, claims 18-22, drawn to a protein having a silencing activity and in comprising a RNA-dependent domain, wherein the domain is homologous to a portion of SEQ ID NO:1.

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Group VIII, claim 23, drawn to a use of the nucleic acid sequence encoding for a protein having a silencing activity and in comprising a RNA-dependent domain, wherein the domain is homologous to a portion of SEQ ID NO:1, for gene silencing.

PCT Rule 13.2 requires that unity of invention exists only when there is a shared same or corresponding technical feature among the claimed inventions. All groupings are directed to a composition having a gene silencing activity, or an organism comprising said composition, but each group has a different special technical feature not shared by the remaining groups. Group I is directed to a nucleic acid encoding for a protein having a silencing activity, which is the special technical feature not shared by the rest of the groups. Group II is directed to a plant comprising said nucleic acid that has the gene silencing activity, which is the special technical feature not shared by the rest of the groups. Group III is directed to a plant with a mutation in the gene encoding the protein that has gene-silencing activity, which is the special technical feature not shared by the rest of the groups. Group IV is directed to a fungus with a mutation in the gene encoding the protein that has gene-silencing activity, which is the special technical feature not shared by the remaining groups. Group V is directed to a non-human animal comprising the nucleic acid that has the gene silencing activity, which is the special technical feature not shared by the remaining groups. Group VI is directed to a non-human animal has a mutation in the gene encoding the protein that has gene-silencing activity, which is the special technical feature not shared by the remaining groups. Group VII is directed to a protein that has gene-silencing activity, which is the special technical feature not shared by the remaining groups. Groups VIII, is drawn to a use of said nucleic acid for gene silencing purpose, which is the special technical feature not shared by the remaining groups. Each of these special technical features involves diverse and separate area of consideration. Therefore, although

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related, the eight groups of inventions are not so linked by a special technical feature within the meaning of PCT Rule 13.2 so as to form a single inventive concept.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celine X Qian whose telephone number is 571-272-0777. The examiner can normally be reached on 9:30-6:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel Ph.D. can be reached on 571-272-0781. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Celine Qian, Ph.D.

Anne-Marie Falk
ANNE-MARIE FALK, PH.D.
PRIMARY EXAMINER